

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANNE C. BATTLE

Appeal No. 1997-1022
Application No. 08/368,359¹

ON BRIEF²

Before CALVERT, MEISTER, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 9, which are all of the claims pending in this application.

¹ Application for patent filed January 4, 1995.

² On May 12, 1999, the appellant filed a request (Paper No. 20) to withdraw their previously filed request for an oral hearing. Such request has been granted.

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We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a clothing insert. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The prior art references of record (i.e., the applied prior art) relied upon by the examiner in rejecting the appealed claims are:

Mann 16, 1971	3,619,819	Nov.
Oram 14, 1995	5,388,275	Feb.
		(filed Oct. 19, 1992)
Moretz et al. 1995 (Moretz)	5,392,467	Feb. 28, (filed Apr. 15, 1993)

Claims 1, 2, 4, 5 and 7 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Oram in view of Mann.

Claims 3 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Oram in view of Mann and Moretz.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed November 1, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 15, filed September 24, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the

examiner's rejection of claims 1 through 9 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on

§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

The examiner determined (answer, pp. 3-4) with respect to claim 1 (the only independent claim on appeal) that (1) Oram discloses a pants insert as claimed except for the insert "being formed of fleece of the sheep skin and adjacent the wearer's skin," (2) the material from which the insert is constructed "has been considered a matter of routine

procedural design," (3) Mann discloses "an insert constructed of fleece type wool and contacting the wearer's skin," and (4) it would have been obvious to one of ordinary skill in the art to modify the insert of Oram "to be constructed of fleece type wool in order to construct a comfortable to the touch impact absorbing pad."

The appellant argues (brief, pp. 4-5) that "the examiner is combining the references based not upon what they teach, but rather upon Applicant's teaching." We agree.

All the claims under appeal require the pants insert to be "formed of fleeced sheep skin." However, this limitation is not suggested by the prior art as applied by the examiner. In that regard, while Mann does teach a mammary prosthesis including a piece of tanned sheepskin the forms the backing piece of the prosthesis wherein the wool face of the sheepskin lies against the skin of the wearer, it is our opinion that such teaching would have been insufficient to have motivated an artisan to have modified Oram's pants insert in the manner proposed by the examiner.

In our view, the only suggestion for modifying Oram in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 through 9.³

REMAND

Claim 1 appears to be directed solely to the pants insert, per se, shown in Figure 1 of the application. Thus, claim 1 may be anticipated by a suitably sized piece of sheep skin that is capable of being used as a pants insert in the manner set forth in claim 1.

³ We have also reviewed the Moretz reference additionally applied in the rejection of dependent claims 3 and 6 but find nothing therein which makes up for the deficiency of Oram and Mann discussed above.

Accordingly, we remand this application for the examiner to determine if claim 1 would be anticipated by a suitably sized piece of sheep skin that is capable of being used as a pants insert in the manner set forth in claim 1 and if so, to find suitable prior art to base such a rejection.⁴

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 9 under 35 U.S.C. § 103 is reversed. In addition, we have remanded this application to the examiner for further consideration.

⁴ If the examiner rejects claim 1 as being anticipated by a suitably sized piece of sheep skin, the examiner should also consider the patentability of dependent claims 2 through 6 also drawn to the pants insert, per se. (Claims 7 through 9 are drawn to the combination of the pants insert and a pair of pants.)

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED and REMANDED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/368,359

APJ NASE

APJ MEISTER

APJ CALVERT

DECISION: **REVERSED & REMANDED**

Prepared By: Gloria Henderson

DRAFT TYPED: 01 Jun 99

FINAL TYPED: